

APR 25 2003

HDP/SB/21 based on PTO/SB/21 (08-00)

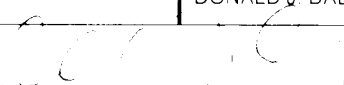
AF/2841

Please type a plus sign (+) inside this box → ☐

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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/824,481
	Filing Date	April 2, 2001
	First Named Inventor	Tomoyuki SEKI et al.
	Group Art Unit	2841
	Examiner Name	D.E. Levi
	Attorney Docket Number	5077-000028/US

ENCLOSURES (check all that apply)				
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers <i>(for an Application)</i> <input type="checkbox"/> Drawing Correction Approval Request w/ 2 sheets of drawings <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) <i>(please identify below)</i> *		
<table border="1"><tr><td>Remarks</td><td></td></tr></table>			Remarks	
Remarks				

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name DONALD J. DALEY	Reg. No. 34,313
Signature			
Date	APRIL 25, 2003		

10/2002

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL
for FY 2003

APR 5 2023

Patent fees are subject to annual revision.

Complete if Known

Application Number	09/824,481
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Filing Date	April 2, 2001
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Inventor(s)	Tomoyuki SEKI et al
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Examiner Name	D E Levi
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Group / Art Unit	2841
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Attorney Docket No	5077-000028/US
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TOTAL AMOUNT OF PAYMENT	(\$)	110.00
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METHOD OF PAYMENT (check one)

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to

Deposit Account Number	08-0750
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Deposit Account Name	Harness, Dickey & Pierce, P.L.C
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☒ Charge Any Additional Fee Required
Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status
See 37 CFR 1.27

2. ☒ Payment Enclosed.

☒ Check ☐ Credit card ☐ Money Order ☐ Other

EFF CALCULATION

1 BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	750	201	375	Utility filing fee	
106	330	206	165	Design filing fee	
107	520	207	260	Plant filing fee	
108	750	208	375	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1)

(S) 0

2. EXTRA CLAIM FEES

			Extra Claims		Fee from below		Fee Paid
Total Claims	<input type="text"/>	** =	<input type="text" value="0"/>	X	<input type="text"/>	=	<input type="text" value="0"/>
Independent Claims	<input type="text"/>	** =	<input type="text" value="0"/>	X	<input type="text"/>	=	<input type="text" value="0"/>
Multiple Dependent				X	<input type="text"/>		<input type="text" value="0"/>

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

5

FEE CALCULATION (continued)

3 ADDITIONAL FEES

Fee Code	Large Entity Fee (\$)	Small Entity Fee (\$)	Fee Description	Fee Paid
105	130	65	Surcharge - late filing fee or oath	
127	50	25	Surcharge - late provisional filing fee or cover sheet	
139	130	65	Non-English specification	
147	2,520	1,260	Fee for filing a request for reexamination	
112	920*	460*	Requesting publication of SIR prior to Examiner action	
113	1,840*	920*	Requesting publication of SIR after Examiner action	
115	110	55	Extension for reply within first month	110
116	410	205	Extension for reply within second month	
117	930	465	Extension for reply within third month	
118	1,450	725	Extension for reply within fourth month	
128	1,970	985	Extension for reply within fifth month	
119	320	160	Notice of Appeal	
120	320	160	Filing a brief in support of an appeal	
121	280	140	Request for oral hearing	
138	1,510	755	Petition to institute a public use proceeding	
140	110	55	Petition to revive – unavoidable	
141	1,300	650	Petition to revive – unintentional	
142	1300	650	Utility issue fee (or reissue)	
143	470	235	Design issue fee	
144	630	315	Plant issue fee	
122	130	65	Petitions to the Commissioner	
123	50	25	Processing fee under 37 CFR 1.17 (g)	
126	180	90	Submission of Information Disclosure Stmt	
581	40	20	Recording each patent assignment per property (times number of properties)	
146	750	375	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	750	375	For each additional invention to be examined (37 CFR § 1.129(b))	
119	750	375	Request for Continued Examination (RCE)	
169	900	450	Request for expedited examination of a design application	
Other fee: specify _____				

Other fee spent:

16917 18000

[illegible]

3. *Staphylococcus aureus*

Date _____

APPENDIX 2 (continued)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTC 2038.

APR 25 2003

BOX AF
RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE EXAMINING
GROUP 2841

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/824,481
Filing Date: April 2, 2001
Applicant: Tomoyuki SEKI et al.
Group Art Unit: 2841
Conf. No.: 9071
Examiner: D.E. Levi
Title: DISCHARGE LAMP AND LAMP UNIT
Attorney Docket: 5077-000028/US

RECEIVED

2841

2841

Commissioner of Patents and Trademarks
Washington, D.C. 20231

April 25, 2003

REPLY UNDER 37 C.F.R. 1.116

Sir:

In reply to the Final Office Action mailed December 26, 2002, the due date having been extended one (1) month to April 26, 2003, the following amendments and remarks are respectfully submitted in connection with the above-identified application.

REMARKS

1. The present application is directed to a discharge lamp and lamp unit.

PRIOR ART REJECTION

The Examiner has rejected claims 1-4 and 9-22 under 35 U.S.C. § 103 as being unpatentable over Matthews et al. (the Matthews '063 patent) in view of Mochiduki et al. (the Mochiduki '973 patent). This rejection is respectfully traversed.

Based on the Examiner's final rejection, the Examiner essentially agrees with Applicants, admitting that the prior art Matthews '063 patent fails to teach or suggest at least the limitation of claim 1 "wherein at least one of the constricted portions is formed in an area of the sealing portion where the metal foil is disposed." Similarly, with regard to claim 14, the Examiner admits that the Matthews '063 patent fails to teach or suggest at least "wherein at least one of the constricted portions is formed in an area between an end of the electrode and an end of the external lead of at least one of the sealing portions". In an attempt to make up for each of these deficiencies, the Examiner attempts to combine the teachings of the Matthews '063 patent with those of the Mochiduki '973 patent, and specifically with alleged constricted portions adjacent element 16A and 16B of Fig. 5 of the Mochiduki '973 patent. Applicants respectfully submit that the Examiner has not provided sufficient teaching, suggestion, or motivation to combine the teachings of the Mochiduki '973 patent with those of the Matthews '063 patent, even assuming *arguendo* that the teachings of the Mochiduki '973 patent would, even if combinable, make up for the aforementioned admitted deficiencies of the Matthews '063 patent.

LACK OF MOTIVATION

based upon a combination of elements disclosed in the prior art, there must be some motivation,

suggestion or teaching of the desirability of making the specific combination that was made by the Applicants. The motivation, suggestion, or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill in the art, or in some cases, the nature of the problem to be solved. See *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999) and *In re Kotzab*, 55 USPQ 1313 (Fed. Cir. 2000). In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must provide particular findings as to why the two pieces of prior art are combinable. Broad conclusory statements standing alone are not "evidence". See, *In re Dembiczak*, 50 USPQ2d at 1617.

Matthews Provides No Motivation

As admitted by the Examiner, the Matthews '063 patent clearly fails to teach or suggest constricted portions formed in an area of the sealing portion where the "metal foil is disposed" as set forth in claim 1 and between an end of an electrode and the end of a lead as set forth in claim 14. In the Matthews '063 patent, the particular configuration envelope includes a first envelope portion surrounding the foil member 30, as shown in Fig. 1 and as discussed in col. 2, lines 17-21. In col. 3, lines 29-41, it further teaches how a portion of the lamp 16 or 18, surrounding the foil member, is heated until the quartz is softened and then the softened quartz is caused to collapse about the foil member. The claims of the Matthews '063 patent, including element D of claim 1, further emphasize "a first envelope portion surrounding said foil member". Accordingly, it is clear from the Matthews '063 patent that the bulb is processed so as to surround the foil member and not to provide at least one constricted portion ... where the "foil

Matthews '063 patent for providing such a constricted portion in an area to where the metal foil is disposed.

No Motivation In Mochiduki

The Mochiduki '973 patent is directed to an electric discharge lamp apparatus, wherein a predetermined gap S2 is provided between an insulating sleeve 38 and a lead support as shown in Fig. 5 of the device. This gap, and a bend in element 36A as shown in Fig. 5, are clearly stressed as the inventive aspects of the Mochiduki '973 patent (see col. 7, lines 57-65 for example, as well as col. 10, lines 18-24). Further, claim 1 of the Mochiduki '973 patent includes the limitation of the metal lead support including a bent portion.

Regarding Fig. 5 of the Mochiduki '973 patent, Fig. 5 of the application arguably shows a varied portion of the lamp around foil members 16A and 16B. However, there is no explanation as to how or why these varied portions exist, let alone what function they serve. In fact, the portions are not even labeled nor are they ever mentioned as "constricted portions". In Fig. 1, 2 and 7, and thus in each of the figures of the application except for Fig. 5, such an alleged "constricted portion" is not even shown.

Applicants respectfully submit that as the alleged "constricted portion" of the Mochiduki '973 patent allegedly shown in Fig. 5 is not even explained or acknowledged, then the Mochiduki '973 patent clearly cannot provide any motivation for applying this alleged teaching to the device of the Matthews '063 patent. There is no teaching, suggestion, or motivation that could be gleaned by one of ordinary skill in the art from the Mochiduki '973 patent which would

or to include at least one constricted portion in an area between an end of the electrode and an end of the external lead as claimed in claim 14.

Use Of Applicants' Invention In Hindsight

Applicants respectfully submit that the Examiner has merely utilized Applicants' invention, in hindsight, to combine the teachings of the two references. Absent Applicants' invention, there is clearly no proper teaching, suggestion or motivation which would lead one of ordinary skill in the art to combine the alleged constricted portions of the Mochiduki '973 patent (even assuming *arguendo* that they actually exist, which Applicants do not admit), with the teachings of the Matthews '063 patent.

In the background of the present application, Applicants state, on page 4 for example, that the inventors of the present application found that the lifetime of the conventional lamp was shortened by the fact that certain gaps existed in the lamp which caused an internal stress between a foil 124 and a glass portion 122 as shown in Figs. 9A and 9B of the application. Further, on page 8 of the present application, Applicants state that they discovered that by including at least one constricted portion in an area of the metal foil for example, internal stress from the metal foil in the constricted portion could be relatively larger than that in other portions. As such, the metal foil could be deformed (thermally expanded) selectively in the constricted portion and as a result, the metal foil and the constricted portion could stop the gas from proceeding in the sealing portion. Thus, the sealing structure (and the lamp) could be maintained for a long time (see page 8, lines 7-20 for example).

which has been utilized by the Examiner, in hindsight, to combine the teachings of the prior art.

Conclusory Statements Are Not Evidence Of Motivation

When patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002), citing, *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). The factual inquiry of whether to combine references must be thorough when searching and it must be based on suggestive evidence of record. The Examiner's conclusory statements do not adequately address the issue of motivation to combine. See *In re Sang-Su Lee*, at 1443. When reviewing the patents and other objective evidence of record, it is clear that nothing in the record provides any teaching or suggestion or motivation to combine the teachings of the two patents, even assuming *arguendo* that the teaching of the constricted portion in the area of metal foil or in an area between an end of the electrode and an end of the external lead of at least one of the sealing portions, is even present in the Mochiduki '973 patent (which Applicants do not admit).

Applicants respectfully submit that the Examiner has merely set forth conclusory statements as alleged motivation for combining teaching of the references. The Examiner alleges that it would have been obvious to one of ordinary skill in the art to have formed the constricted portions as taught by the Mochiduki '973 patent in a luminance bulb as taught in the Matthews '063 patent "for the purpose of tightly sealing the sealing portion in the vicinity of the metal foil thereby ensuring good contact therein". The Examiner has not provided any source for this

to independent claim 14, and this alleged motivation is similarly merely conclusory in nature and thus is not proper.

No Prima Facie Case Of Obviousness

Accordingly, Applicants respectfully submit that the Examiner has not established a proper *prima facie* case of obviousness because the Examiner has not provided proper motivation for combining the references. Accordingly, withdrawal of the rejection and allowance of each of the claims in connection with the present application is earnestly solicited.

TEACHING AWAY

Further, Applicants respectfully submit that since the Matthews '063 patent emphasizes, throughout the patent, that the foil member should be surrounded, the application of constricted portions around an area of the foil member as alleged by the Examiner would be actually a teaching away from the combination of references. In other words, not only does the Matthews '063 patent not provide any teaching, suggestion or motivation for including any constricted portions in the area of the foil member, but the inclusion of any such constricted portions would actually destroy the teachings of the Matthews '063 patent and thus would teach away from the alleged combination of the Matthews '063 patent and the Mochiduki '973 patent. Such a teaching away is an even further extension of the lack of motivation argument which even further suggests that the Examiner has failed to establish a probable *prima facie* case of obviousness.

reasons previously presented regarding their corresponding independent claims. Further,

additional dependent claims even further emphasize various points made by the Examiner. For example, with regard to the limitations of claims 2 and 18, stating that at least one constricted portion is provided in a portion relatively nearer to the luminous bulb side, rather than the center of the sealing portion, such a teaching or suggestion is not taught or suggested by any of the references of record, even assuming *arguendo* that they could be combined. For example, since the Mochiduki '973 patent did not even discuss why its "alleged" constricted portions are even included, it cannot provide any teaching or suggestion for providing a constricted portion in a certain position or portion of the sealing portion. Similarly, the Matthews '063 patent provides no such motivation. Accordingly, many of the dependent claims even further emphasize that the Examiner has not provided proper motivation for combining the references, and has merely utilized Applicants' motivation in hindsight.

Still further, the claims such as claim 3 require a plurality of constricted portions. This is not taught or suggested by either the Matthews '063 patent or the Mochiduki '973 patent, even assuming *arguendo* that they could be combined.

ENTRY OF AFTER FINAL AMENDMENT IS PROPER

As the claims of the present application have not been amended, the present Reply Under C.F.R. 1.116 does not raise any new issues which will require further consideration and/or search. Accordingly, entry of this Reply Under C.F.R. 1.116 is deemed to be proper.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of all outstanding objections and rejections and allowance of each of claims 1-4 and 9-22 in connection with the present application is earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required \$110.00 extension fee herewith

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley, Reg. No. 34,313 at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By

Donald J. Daley, Reg. No. 34,313

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000